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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.		
10/735,631	12/16/2003	Sang-hyub Lee	1793.1067	2658		
21171	7590	10/16/2008	EXAMINER			
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				BLOUIN, MARK S		
ART UNIT		PAPER NUMBER				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/735,631	LEE, SANG-HYUB	
	<b>Examiner</b>	<b>Art Unit</b>	
	MARK BLOUIN	2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 02 September 2008.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,2,7,8,13,15 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,2,7,8,13,15, and 17-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____.   | 6) <input type="checkbox"/> Other: _____ .                        |

## **Detailed Action**

### ***Response to Amendment***

- The reply filed on September 2, 2008 was applied to the following effect: Claims 1,7,13,17, and 20 were amended, and Claims 4,10,16, and 22 were cancelled

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1,2,7,8,13,15, and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Brannon et al (USPN 6,530,258).
3. Regarding Claims 1,7,13, and 20, Brannon et al shows (Figs. 1-4) a head flying height measurement apparatus comprising: a disk (115) having a plurality of protrusions (45) with a height greater than an estimated flying height of a slider formed on a surface of the disk; a head assembly of a disk drive having a magnetic head and a slider (129) disposed at an end of the head assembly, wherein the slider floats above the disk when the disk is rotated and cuts the protrusions to leave a portion of each protrusion below a bottom edge of the slider on the surface of the disk; and a measurement device (Col 4, lines 19-29), wherein the measurement device measures a height of the portion of the protrusions remaining on the surface of the disk that corresponds to a flying height of the slider and the protrusion is formed by migrating a product to

the surface of the disk from a base layer of the disk through a pinhole to form a corrosion product.

**Examiner's Note:** While the claims have been amended to include indicated allowable subject matter, it is noted, that the claimed limitations, e.g., exemplified by claim 1, "... the *protrusion is formed* by migrating a product to the surface of the disk..." (emphasis added) are in fact, process limitations with a claimed product. That is, the product by process limitations in these claims are directed to the product *per se*, no matter how actually made, *In re Hirao*, 190 USPQ 15 at 17(footnote 3). See also *In re Brown*, 173 USPQ 685; *In re Luck*, 177 USPQ 523; *In re Fessman*, 180 USPQ 324; *In re Avery*, 186 USPQ 161; *In re Wertheim*, 191 USPQ 90 (209 USPQ 554 does not deal with this issue); *In re Marosi et al*, 218 USPQ 289; and particularly *In re Thorpe*, 227 USPQ 964, all of which make it clear that it is the patentability of the final structure of the product "gleaned" from the process limitations or steps, which must be determined in a "product by process" claim, and not the patentability of the process limitations. Moreover, an old or obvious product produced by a new method is not a patentable product, whether claimed in "product by process" claims or not. Note that the applicant has the burden of proof in such cases, as the above case law makes clear.

The Examiner recommends reciting the limitation with structural features such as "the disk comprises a plurality of pinholes...", etc.

4. Regarding Claims 2 and 8, Brannon et al shows (Figs. 1-4) the head assembly is a magnetic head assembly and the disk is a magnetic recording disk (115).

5. Regarding Claim 15, Brannon et al shows (Figs. 1-4) the method, wherein the determining of the actual flying height comprises measuring the cut protrusion with an AFM (Col 2, lines 13-21).

6. Regarding Claim 17, Brannon et al shows (Figs. 1-4) the method, wherein the determining of the actual flying height comprises measuring the cut protrusion (45/47) with a scanning probe microscopy (Col 2, lines 13-21).

7. Regarding Claim 18, Brannon et al shows (Figs. 1-4) the method, further comprising: installing the disk having protrusions formed on the surface in a hard disk drive having the slider of the head assembly; and removing the disk from the hard disk drive after the cutting of the protrusion and prior to the determining of the actual flying height of the slider (Col 2, lines 1-43).

8. Regarding Claim 19, Brannon et al shows (Figs. 1-4) the method wherein the hard disk drive includes a plurality of disks having protrusions formed on the surface and a plurality of sliders corresponding to the plurality of disks (Col 3, line 28).

### *Conclusion*

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Blouin whose telephone number is 571-272-7583. The examiner can normally be reached on M-F from 6:00 to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joe Feild, can be reached on 571-272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Mark Blouin/

Primary Examiner of Art Unit 2627

Mark Blouin  
Patent Examiner  
Art Unit 2627  
October 8, 2008